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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/771,081

02/04/2004

Jon Muskin

MUS-02

1948

43536 7590 05/18/2007
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EXAMINER

HU, KANG

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

05/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/771,081

Applicant(s)

MUSKIN, JON

Examiner

Kang Hu

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-23, 26-28 and 33-48 is/are pending in the application.
- 4a) Of the above claim(s) 14-19, 23, 26-28 and 33-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/11/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The response to restriction requirement has been entered on 2/11/2007. Claims 1-13, 24, 25, and 29-32 have been cancelled, claims 14-19, 23, 26-28 has been withdrawn, claims 33-48 has been added and has been withdrawn from consideration. Claims 20-22 are currently pending in the present application.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 20-22, drawn to a method of assigning monetary ticket a dollar amount, and assigning the ticket as a special payable ticket, classified in class 463, subclass 27.
 - II. Claims 33-48, drawn to a system and method of issuing a special payment versus standard payment, classified in class 463, subclass 25. The system and the method of determining special payout are one of the same.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the issuance of a special payment does not require the issuance of a special payable ticket. The subcombination has separate utility such as being able to alter the payable of a player on an electronic gaming machine.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required, because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Since the applicant has already received a restriction action and has elected grouping IV (claims 20-22) without traverse, this invention has been constructively elected by the response to restriction requirement for prosecution originally presented. Accordingly, claims 33-48 are withdrawn from consideration as being directed to a non-elected invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Schneider et al. (US 2004/0142742 A1).

Re claim 20, Schneider teaches a method, comprising: assigning a monetary ticket a dollar amount; designating the monetary ticket as a special payable ticket; crediting the dollar amount

into a gaming machine; and playing a gambling game using a modified payable designated by the monetary ticket in figs 6-19 where Schneider stores souvenir rewards as well as cash rewards on the club card (monetary ticket), downloading special pay tables (§ 40-44) and having the electronic gaming machine change its current pay table to one that is personalized for that player.

Re claims 21 and 22, Schneider also teaches of a method as recited in claim 20, further comprising: receiving a ticket out request from the gaming machine; and issuing a second monetary ticket designating the special payable reflecting a current amount of credits on the gaming machine and restricting use of the ticket to a particular patron (§ 3, 14, 15, 26, 28, 29, 35, 40-44).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Russell et al (US 2005/0119052) discloses a player specific network allowing player to have a unique gaming experience, different than other players, even when playing on the same network. Luciano, Jr. (US 6,875,107) discloses a system and method of increasing player's participation and entertainment value in the play of a gaming device in slot machine by offering a prize award such as product or service for player obtaining a predetermined outcome.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kang Hu whose telephone number is (571)270-1344. The examiner can normally be reached on 8-5 (Mon-Thu).


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

1/28

Kang Hu
May 3, 2007


Kathleen Mosser
Primary Examiner
Art Unit 3714